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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,580	06/19/2001	Stephen J. Boies	YOR920000496US1	2574

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EXAMINER

SMITH, TRACI L

ART UNIT PAPER NUMBER

3629

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,580

Applicant(s)

BOIES ET AL.

Examiner

Traci L Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☒ Claim(s) 31-39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 31-39 recites the limitation "the computer program product" in the preamble. There is insufficient antecedent basis for this limitation in the claim.
3. Claims 3 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 3 the applicant fails to point out what is the entry that is being looked up and who is doing the looking up. In claim 12 the applicant fails to point out what qualifies as a "selection".

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

6. In the present case, claims 1-13 are rejected for not being directed to statutory subject matter. The above mentioned claims can all be performed by a human process.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6 192 341 B1; Becker; Feb. 20, 2001.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

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inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

9. A generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus." The species in the aforementioned case will anticipate the genus claimed in the instant application. In re Slayter, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960); In re Gosteli, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989)

10. As to claims 1, 14 and 27 they read on claim 1 of Becker.

11. As to claim 2, 15 and 28 they read on claim 4 of Becker.

12. As to claims 3, 16 and 29 they read on claim 5 of Becker.

13. As to claims 4, 17 and 30 they read on claim 13 of Becker

14. As to claims 5, 11-13, 18, 24-26, 31 and 37-39 they read on claim 15 of Becker.

15. As to claims 7, 20 and 33 they read on claim 6 of Becker.

16. As to claims 8, 21 and 34 they read on claim 30 of Becker.

17. As to claims 9-10, 22-23 and 35-36 they read on claim 7 of Becker.

18. As to claims 6, 19 and 32 they read on claim

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

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said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

21. Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6 591 008 B1; Surve et al. and further in view of US Patent 5 974 116 Engelke et al.

22. As to claims 1, 14 and 27 A method for providing information content to a user, comprising:

23. receiving an identification of the user; **Surve teaches an individuals profile(c.**

1 I.51-52)

24. determining one or more physical limitations of the user regarding receipt and/or interpretation of the information content based on the identification of the user; and **Surve teaches identifying a limitation but fails to teach interpretation; Engelke teaches a system, method and apparatus for interpreting a conversation. It would have been obvious to one skilled in the art at the time of invention to combine the teaches of Engelke with Surve so as to have a device capable of assisting an individual with a hearing limitation.(C2 I. 54)**

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25. outputting information content to the user based on the one or more physical limitations of the user. **Surve teaches displaying content adjusted to the person; (c. 1 l. 50-51)**

26. As to claim 2, 15 and 28 Surve teaches determining the limitation of a person(C. 1 l. 51-51)

27. As to claim 3, 16, and 29 Surve teaches a storage for profiles. Engelke teaches storage for interpreter(c.3 l. 66-67). It would have been obvious to one skilled in the art at the time of invention to combine the teaches of Engelke with Surve to allowing for recognition of persons when they use the service repetitively.

28. As to claims 4-5, 11-13, 17-18, 24-26, 30-31 and 37-39 Surve(C.1 and l. 64-65) and Engleke(C. 6 l. 33-37) teach outputting information in a reformatted and/or enhanced style according to the user limitations. Although neither reference explicitly teaches all the identified physical limitations claimed the examiner takes notice that these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps of outputting information would be performed regardless of the physical limitation of the user. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994).

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29. As to claims 6, 19 and 32 Surve teaches a limitation of visual impairment (C. 1 I. 49-50)

30. As to claims 7, 20 and 33 Surve teaches receiving information content from the user. (C.1 I.67; C. 2 I. 1-2)

31. As to claims 8, 21 and 34 teaches the display as a computer, TV, PDA or a control panel.(C. 2 I.44-46).

32. As to claims 9-10, 22-23 and 35-36 teaches enhancing reformation digital images.(C. 2 I.57).

Conclusion

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Foreign Patent JP 2003050766 A; Method, Apparatus and Program for accessing web image through multiple image resolutions. Non-Patent Literature article Business Wire ; "eAssist.com Delivers Interactive E-customer support for Concierge Inc."

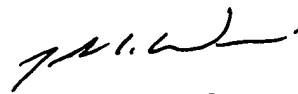
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L Smith whose telephone number is (703)605-1155. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tls


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